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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,519	05/04/2001	David G. Beshore	38190/233565	7542

826 7590 06/27/2005

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EXAMINER
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STIMPAK, JOHNNA

ART UNIT	PAPER NUMBER
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3623

DATE MAILED: 06/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/848,519

Applicant(s)

BESHORE, DAVID G.

Examiner

Johnna R. Stimpak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 04 May 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/4/01</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The following is a first office action upon examination of application number 09/848,519.

Claims 1-20 are pending and have been examined on the merits discussed below.

#### ***Claim Rejections - 35 USC §101***

2. Claims 1-6 and 15-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-6 and 15-20 only recite an abstract idea. The recited steps of merely acquiring information concerning an organization and a process, developing preliminary findings, voting for a conclusion associated with the preliminary findings and developing final findings or assessments does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper.

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These steps only constitute an idea of how to develop findings concerning the assessment of a process.

Additionally, for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. In the present case, the claimed invention develops preliminary findings, allows for voting for a conclusion based on the preliminary findings and develops final findings based on the vote (i.e., repeatable, useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claim 1 is deemed to be directed to non-statutory subject matter.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Ferguson, US 5,995,951.

As per claim 1, Ferguson teaches acquiring information concerning the organization and the process (column 5, lines 12-17 – a user selects a problem to be solved based on the organization or process); developing a plurality of preliminary findings based upon the information, wherein each preliminary finding has an associated characterization from a group consisting of a strength and a weakness (column 5, lines 18-22 – based on the initial proposed

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solutions, the users submit, review and rank them to select a certain number for further refinement and consideration); voting for a conclusion associated with each preliminary finding, wherein said voting occurs electronically, and wherein the conclusion associated with each preliminary finding is selected from a group consisting of an agreement with the preliminary finding and a disagreement with the preliminary finding (column 5, lines 23-27 – the ranked solutions from the initial proposed solutions are reviewed and ranked); and developing a plurality of final findings, wherein each final finding has the characterization, and wherein the plurality of final findings are based upon said voting for the conclusion associated with each preliminary finding (column 5, lines 40-43 – a final proposed solution is synthesized based on the proposed solution).

As per claim 2, Ferguson teaches acquiring information comprises acquiring a first set of information from a plurality of questionnaires, and acquiring a second set of information from at least one of a plurality of interviews and at least one document review, and wherein developing the plurality of preliminary findings is based upon the first set of information and the second set of information (figure 7. and column 6, lines 16-20 – this is submitted to the user through the internet – inherently this is a questionnaire since it is asking the user to submit a proposal(s), figure 10. and column 7, lines 35-41 – for the second round another form is displayed to the user; it is considered an interview since it is requesting information from the user – this document is reviewed to determine a certain number of proposals).

As per claim 3, Ferguson teaches collating the first set of information after acquiring the first set of information from the plurality of questionnaires, wherein said collating comprises identifying at least one of a preliminary finding and information for further review (column 6,

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lines 16-33 – a first ranking of initial proposed solutions takes place after collecting information from the questionnaires), and wherein said acquiring a second set of information comprises acquiring the second set of information at least partially based upon the information for further review (column 6, lines 45-53 – the user votes on information from a plurality of questionnaires regarding proposed solutions which are then ranked) (see also figures 7-9) .

As per claim 4, Ferguson teaches the voting comprises voting by a plurality of participants for a conclusion based upon each preliminary finding, and wherein said voting occurs anonymously (figure 5 – there is a check box wherein the process can be performed anonymously).

As per claim 5, Ferguson teaches voting comprises voting by at least one assessor and at least one member of the organization (column 5, line 63 – column 6, line 6 – a decision maker defines the number of participants and also specified which users will participate by user name or number – inherently a member of the organization is selected and also an assessor is selected since by definition an assessor is, by definition, one who assesses which is exactly what is taking place, there is an assessment of the proposed solutions).

As per claim 6, Ferguson teaches voting further comprises voting for a valuation associated with each preliminary finding, wherein the valuation associated with each preliminary finding is selected from a group consisting of an agreement with the characterization of the preliminary finding and a disagreement with the associated characterization of the preliminary finding, and wherein said developing the plurality of final findings are further based upon said voting for the valuation based upon the characterization associated with each preliminary finding (column 6, lines 1-44 – each initial proposed solution is voted on or ranked to determine initial or

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preliminary findings – inherently the selection of the initial solutions that are selected for another round of voting are based on agreement or disagreement, those that are agreed with are then chosen for submittal for another round of voting, those that are disagreed with are not submitted for voting – these initial proposed solutions that are selected are then voted upon to determine a final proposed solution).

Claims 7-12 are the computer program product for performing the method of claims 1-6, respectively. Therefore since Ferguson teaches a computerized system (column 4, lines 19-65), the same rejections as applied to claims 1-6 are applied to claims 7-12.

As per claim 13, Ferguson teaches the first executable portion is adapted to at least partially acquire information via a wide area network (WAN), wherein the second executable portion is adapted to present the plurality of developed preliminary findings via the WAN, and wherein the third executable portion is adapted for voting via the WAN (column 4, lines 19-65 and column 5, line 60 – column 6, line 33 – each process of acquiring information, developing findings and voting are all carried out over a system using the Internet).

As per claim 14, Ferguson teaches the WAN comprises the Internet (column 4, lines 19-65 and column 5, line 60 – column 6, line 33 – each process of acquiring information, developing findings and voting are all carried out over a system using the Internet).

As per claim 15, Ferguson teaches acquiring information concerning the organization and the process (column 5, lines 12-17 – a user selects a problem to be solved based on the organization or process); developing a plurality of preliminary findings based upon the information, wherein each preliminary finding has an associated characterization from a group consisting of a strength and a weakness (column 5, lines 18-22 – based on the initial proposed

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solutions, the users submit, review and rank them to select a certain number for further refinement and consideration); voting for a conclusion associated with each preliminary finding, wherein said voting occurs electronically, and wherein the conclusion associated with each preliminary finding is selected from a group consisting of an agreement with the preliminary finding and a disagreement with the preliminary finding (column 5, lines 23-27 – the ranked solutions from the initial proposed solutions are reviewed and ranked); and developing at least one assessment, wherein each assessment has an associated characterization, and wherein the associated characterization of each assessment is based upon said voting for the conclusion associated with each preliminary finding (column 5, lines 40-43 – a final proposed solution is synthesized based on the proposed solution).

As per claim 16, Ferguson teaches acquiring information comprises acquiring a first set of information from a plurality of questionnaires, and acquiring a second set of information from at least one of a plurality of interviews and at least one document review, and wherein developing the plurality of preliminary findings is based upon the first set of information and the second set of information (figure 7. and column 6, lines 16-20 – this is submitted to the user through the internet – inherently this is a questionnaire since it is asking the user to submit a proposal(s), figure 10. and column 7, lines 35-41 – for the second round another form is displayed to the user; it is considered an interview since it is requesting information from the user – this document is reviewed to determine a certain number of proposals).

As per claim 17, Ferguson teaches collating the first set of information after acquiring the first set of information from the plurality of questionnaires, wherein said collating comprises identifying at least one of a preliminary finding and information for further review (column 6,

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lines 16-33 – a first ranking of initial proposed solutions takes place after collecting information from the questionnaires), and wherein said acquiring a second set of information comprises acquiring the second set of information at least partially based upon the information for further review (column 6, lines 45-53 – the user votes on information from a plurality of questionnaires regarding proposed solutions which are then ranked) (see also figures 7-9) .

As per claim 18, Ferguson teaches the voting comprises voting by a plurality of participants for a conclusion based upon each preliminary finding, and wherein said voting occurs anonymously (figure 5 – there is a check box wherein the process can be performed anonymously).

As per claim 19, Ferguson teaches voting comprises voting by at least one assessor and at least one member of the organization (column 5, line 63 – column 6, line 6 – a decision maker defines the number of participants and also specified which users will participate by user name or number – inherently a member of the organization is selected and also an assessor is selected since by definition an assessor is, by definition, one who assesses which is exactly what is taking place, there is an assessment of the proposed solutions).

As per claim 20, Ferguson teaches voting further comprises voting for a valuation associated with each preliminary finding, wherein the valuation associated with each preliminary finding is selected from a group consisting of an agreement with the characterization of the preliminary finding and a disagreement with the associated characterization of the preliminary finding, and wherein said developing the plurality of final findings are further based upon said voting for the valuation based upon the characterization associated with each preliminary finding (column 6, lines 1-44 – each initial proposed solution is voted on or ranked to determine initial or

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preliminary findings – inherently the selection of the initial solutions that are selected for another round of voting are based on agreement or disagreement, those that are agreed with are then chosen for submittal for another round of voting, those that are disagreed with are not submitted for voting – these initial proposed solutions that are selected are then voted upon to determine a final proposed solution).

### *Conclusion*

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Brooks et al, US 5,587,935 – integrated software development system including group decision support subsystem, application development subsystem, and bridge subsystem therebetween

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Johnna R. Stimpak whose telephone number is 571-272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

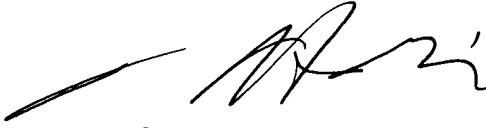
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 571-272-6729. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JS

6/21/05



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